REMARKS

Claims 1-3, 6, 8-11, 13-18, 20, 21, 27, 28, 33, 34, and 37 are pending and stand rejected. Applicant has cancelled claims 4, 5, 7, 12, 19, 22-26, 29-32, 35, and 36. Applicant has amended Claims 1, 6, 8, 10, 13, 16-18, 20, 27, 28, 33, and 34 to clarify their language and to correct various informalities. No surrender of claim scope is intended by the amendments to the remaining claims. The amendments do not add new matter and are supported by the specification as originally filed. No new search is believed to be required. In particular, all limitations added by amendment were already present in the existing claims. Respectfully, Applicant requests reconsideration of the present application in view of the following arguments.

I. Claim Objections

Examiner required clarification of "first lottery" used in the claims. Claims 1, 10, and 13 have been amended to positively recite the first ticket-based lottery game and a separate first jackpot game. These limitations were already present in the claims, and have been expressly called out to improve clarity. No new search is believed to be required. Withdrawal of the objection is respectfully requested.

II. Specification

Applicant thanks Examiner for withdrawing the 35 U.S.C. §112 paragraph one rejection for claims 15 and 16. Examiner urged Applicant to amend the specification to include the omitted subject matter of "adding an amount of money per ticket significantly less than the first-named prize pool" into the specification. Applicant respectfully disagrees that this element is missing from the specification. For,

example, Applicant respectfully submits that paragraph 37 in the original specification describes "accumulating a 'shadow' jackpot of a smaller sum per ticket," while paragraph 215 describes a smaller pool accumulated by adding a certain amount of money per ticket that is "considerably smaller than the amount accumulated for the main pool." Both of these paragraphs describe, "adding an amount of money per ticket significantly less than the first-named prize pool", and, thus, disclose and support the elements recited in claims 15 and 16. Applicant believes that these claims are in condition for allowance and respectfully request withdrawal of the rejection.

III. Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 26-27 stand rejected under 35 U.S.C. § 112, first paragraph, the Examiner contending they fail to comply with the written description requirement. Specifically, the Examiner states that claims 26 and 27 contain subject matter that is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. Claim 26 has been cancelled, and Applicant respectfully submits that the rejection of this claim is moot. Applicant respectfully traverses the rejection for claim 27 for at least the following reasons.

Claim 27 recites " a future draw lottery," and Examiner states this element has no support in the specification. However, for example, the specification at paragraph 237 describes an embodiment that prints a Powerball drawing date on a ticket where the date "refers to a subsequent drawing to be held win which the bar code and human readable number . . . will be used in a drawing determine a prize." Thus, "a future draw lottery" is supported in the specification. For at least the foregoing

reasons, Applicant respectfully requests that the rejection of Claim 27 under 35 U.S.C. § 112, first paragraph be withdrawn.

IV. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that there is insufficient antecedent basis for the term "identification information" as recited in claim 17. Claim 17 has been amended to correct a typographical error, and, thus, Applicant respectfully submits that the rejection is obviated.

For at least the foregoing reasons, Applicant kindly requests that the rejection of claim 17 under 35 U.S.C. § 112, second paragraph, be withdrawn.

V. Claim Rejections Under 35 U.S.C. § 102

Claim 36 stands rejected under 35 U.S.C. § 102 a being anticipated by U.S. Patent 5,944,606 to Gerow ("Gerow"). Claim 36 has been cancelled. Applicant respectfully submits that the rejection is moot.

VI. Claim Rejections Under 35 U.S.C. § 103

A. Claims 1 and 3-6

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerow in view of U.S. Patent No. 5,112,050 to Koza ("Koza"). Examiner also states that claims 10-11 and 37 are obvious in light of Gerow and Koza, but then states that another reference is required. Therefore, claims 10-11 and 37 are discussed below in section B. Claims 4 and 5 have been cancelled,

mooting their rejection. Applicant respectfully submits that neither Gerow, nor Koza, nor their proposed combination renders claims 1, 3, and 6 obvious for at least the following reasons.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the references. See M.P.E.P. § 2142.

With regard to claim 1, Applicant respectfully traverses the proposed combination of Gerow and Koza because the Examiner has not provided a proper motivation to combine. Examiner states that it would have been obvious to combine Koza into the teachings of Gerow "in order to insure the security of the system." No source for the motivation is provided by the Examiner or located by the Applicant. The lack of such a source strongly suggests an improper hindsight reconstruction. The requirement is for "actual evidence" of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002). The fact that references can be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability of the combination or modification. See M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Because there is no particular suggestion from a cited reference, or an affidavit of official notice, Applicant respectfully submits the Examiner's combination is improper and respectfully request withdrawal of the section 103 rejections.

Claim 6 has been amended to incorporate the limitations of cancelled claim 5. Claims 3 and 6 depend from claim 1, and should be patentable for at least the same reasons. See M.P.E.P. §2143.03.

Another requirement for a *prima facie* case of obviousness is that the prior art reference or combination of references must teach or suggest all of the claimed elements. See M.P.E.P. § 2142.

With regard to claim 3, Applicant respectfully traverses the rejection because the proposed combination of Gerow and Koza does not teach all the elements recited in claim 3.

Claim 3 recites:

> The system as in claim 1, in which each of said terminals is connected on-line to said central computer and includes means for transmitting said machine readable ticket code to said central computer, said data storage means and said comparing means being contained in said central computer.

Since Examiner does not cite any reference for disclosing the recited elements of claim 3, Examiner's proposed combination does not teach all of the elements in the recited claim. Because there is no particular suggestion from a cited reference, or an affidavit of official notice, and because the prior art references do not teach all of the recited elements, Applicant respectfully submits the Examiner's proposed combination does not render claim 3 obvious. Withdrawal of the rejection is respectfully requested.

Amended claim 6 recites in relevant part "a match indication is indicated by said comparing means upon dispensing . . .said central computer being programmed to reduce said jackpot prize to a predetermined lower amount upon delivery of said match-indicating signal." Gerow does not teach or suggest "reducing said jackpot prize to a predetermined lower amount upon delivery of said match-indicating signal" upon dispensing. Rather, Gerow generally describes restarting a jackpot upon redemption of the playing card, not upon dispensing as recited in claim 6. Further, Koza does not teach or suggest this feature. Rather, Koza generally

describes broadcasting a winning number to tickets with radio receivers after the player has the ticket. Koza Col. 2:39-40. Thus, neither Gerow, nor Koza, nor their combination teach or suggest "reducing said jackpot prize to a predetermined lower amount upon delivery of said match-indicating signal" upon dispensing. Because this limitation is missing from Examiner's proposed combination, Applicant respectfully submits that claim 6 is not obvious and requests withdrawal of the rejection.

B. Claims 2, 8, 9, 10, 11 and 37

Claims 2, 8, 9, 10, 11 and 37 stand rejected as obvious over Gerow, in view of Koza, and in further view of U.S. Patent 4,982,337 to Burr ("Burr"). Claim 8 was amended to include the limitations of cancelled claim 7. Applicant respectfully traverses this rejection for at least the following reasons.

With regard to claim 10, amended claim 10 recites in relevant part:

> a supervisory computer means connected for communication with ~~a~~ the at least one central computer of each of said independent sub-systems, said supervisory computer means being programmed to receive ticket sales data from each of said sub-systems, determine the amount of a jackpot prize based on said ticket sales data, and communicate information to each of said sub-systems as to the amount of said jackpot prize and the occurrence of a match between a prize code and a ticket code.

The cited references do not teach or suggest a supervisory computer that communicates "information to each of said sub-systems as to the amount of said jackpot prize and the occurrence of a match between a prize code and a ticket code." Examiner admits that Gerow and Koza do not teach or suggest such elements. Burr does not teach them either. Rather, Burr generally describes uploading information to a lottery authority computer to create paperless sales reports for the state lottery agencies. Burr Col. 5:43-46. Thus neither Gerow, nor

Koza, nor Burr, nor their combination teaches or suggests communicating "information to each of said sub-systems as to the amount of said jackpot prize and the occurrence of a match between a prize code and a ticket code." Therefore, Applicant respectfully submits that claim 10 is not obvious. Applicant respectfully requests withdrawal of the rejection.

Claims 2, 8 and 9 depend from claim 1. Claim 11 depends from claim 10. The dependent claims should be patentable for at least the same reasons as claims 1 and 10

Further, regarding claims 10, 11 and 37, Applicant also respectfully traverses the proposed combination of Gerow, Koza and Burr because the Examiner has not provided a proper motivation to combine. Rather, the Examiner appears to pull her proposed reasons for making the combinations from thin air, strong evidence of an improper hindsight reconstruction. Because there is no particular suggestion from a cited reference, or an affidavit of official notice, Applicant respectfully submits the Examiner's alleged motivation is improper and respectfully request withdrawal of the section 103 rejections.

With regard to claims 8-9, Applicant respectfully traverses the proposed combination of Gerow, Koza, and Burr because the Examiner has not provided a proper motivation to combine. Examiner states that it would have been obvious to combine Burr into the teachings of Gerow and Koza "in order to keep data updated and therefore insure the accuracy of the system." No source for this motivation has been provided by the Examiner, and Applicant has not located such a source. Because there is no particular suggestion from a cited reference, or an affidavit of official notice, Applicant respectfully submits the Examiner's alleged motivation is improper and respectfully request withdrawal of the section 103 rejections.

C. Claim 7

Claim 7 stands rejected under 35 U.S.C. § 103 over Gerow, in view of Koza, and in further view of U.S. Patent Re. 35,864 to Weingardt ("Weingardt"). Claim 7 has been cancelled. Applicant respectfully submits the rejection is moot.

D. Claims 12-14, 19-26, 29-32, and 34-35.

Claims 12-14, 19-26, 29-32, and 34-35 stand rejected under 35 U.S.C. §103 over Gerow, in view of U.S. Patent 5,580,311 to Haste, III ("Haste"). Examiner rejected claim 21 for the same reasons as claims 15-17, which were rejected over Gerow in view of Haste, in further view of Weingardt. As such, claim 21 will be discussed in the following section E. Claims 12, 19, 22-26, 29-32, and 36 have been cancelled, and Applicant respectfully submits that the rejection for these claims is moot. Claims 13, 20 and 34 have been amended to incorporate the limitations of their parent claims. Applicant respectfully traverses the rejections for claims 13-14, 20, and 34 for at least the following reasons.

Amended claim 13 recites in relevant part "starting to accumulate a new prize pool upon the detection of the dispensing of an additional ticket after the detection of said winner." Gerow neither teaches nor suggests this feature. Rather Gerow restarts the jackpot after each card has been redeemed, Gerow Col. 7:9-10, not "upon detection of the dispensing of an additional ticket" as recited in claim 13. Further, Haste does not teach or suggest such a feature. Rather, Haste generally describes a pull-tab dispenser for pull-tab instant win games. Neither Gerow, nor Haste, nor their combination teach or suggest "starting to accumulate a new prize pool upon the detection of the dispensing of an additional ticket after the detection of said winner." Thus, Applicant respectfully submits that claim 13 is not obvious.

As an initial matter, claim 14 depends from claim 13 and should be patentable for at least the same reasons as claim 13.

Moreover claim 20 and 34 recite similarly to claim 13. Claim 20 recites in relevant part "using code readers to detect the dispensing of each ticket . . .starting a new prize pool at a lower amount than in said jackpot prize, pool after said winner has been detected." Claim 34 recites in relevant part "stopping the accumulation of the jackpot prize amount when the winning ticket for the jackpot game is dispensed." Since, as stated above for claim 13, Gerow generally describes resetting the jackpot after redemption, and Haste generally describes a pull-tab dispenser for pull-tab instant win games, Gerow and Haste do not teach or suggest the recited elements of claims 20 and 34. Thus, as above for claim 13, Applicant respectfully submits that claims 20 and 34 are not obvious.

E. Claims 15-18, and 21

Claims 15-18 stand rejected under 35 U.S.C. § 103 over Gerow in view of Haste, in further view of Weingardt. Examiner states that claim 21 is rejected for the same reasons as 15-17. Applicant traverses the rejection for at least the following reasons.

As an initial matter, claims 15-18 depend from claim 13. Claim 21 depends from claim 20. The dependent claims should be patentable for at least the same reasons as claims 13 and 20.

With regard to claim 15, Applicant respectfully traverses the proposed combination of Gerow, Haste, and Weingardt because the Examiner has not provided a proper motivation to combine. Examiner states that it would have been obvious to combine Weingardt into the teachings of Gerow and Haste "in order to provide an attractive initial value of the new (second) prize pool and therefore

avoiding to have a $0 initial value which would not attract players." No source for this motivation has been provided by the Examiner, and Applicant has not located such a source. The Examiner can not use Applicant's disclosure as a road map for a hindsight picking and choosing of features. Because there is no particular suggestion from a cited reference, or an affidavit of official notice, Applicant respectfully submits the Examiner's combination is improper and respectfully request withdrawal of the section 103 rejections.

Regarding claims 17 and 18, Applicant also respectfully traverses the proposed combination of Gerow, Haste and Weingardt because the Examiner has not provided a proper motivation to combine. Because there is no particular suggestion from a cited reference, or an affidavit of official notice, Applicant respectfully submits the Examiner's combination is improper and respectfully request withdrawal of the section 103 rejections.

F. Claims 27-28 and 33

Claim 27-28 and 33 stand rejected under 35 U.S.C. § 103 over Gerow in view of Haste in further view of Koza. Applicant respectfully traverses the rejections for at least the following reasons.

With regard to claim 33, Applicant respectfully traverses the proposed combination of Gerow, Haste and Koza because the Examiner has not provided a proper motivation to combine. Examiner states that it would have been obvious to combine Koza into the teachings of Gerow "in order to ensure the security of the system." The requirement is for "actual evidence" of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002). No source for this motivation has been provided by the Examiner, and Applicant has not located such a source. Because there is no

particular suggestion from a cited reference, or an affidavit of official notice, Applicant respectfully submits the Examiner's combination is improper and respectfully request withdrawal of the section 103 rejections.

With regard to claim 28, claim 28 recites in relevant part "whether the game ticket wins the jackpot is determined randomly at the time the game ticket is dispensed." Gerow does not teach or suggest determining a jackpot winner "randomly at the time the game ticket is dispensed." Rather, Gerow generally describes predetermined jackpot cards. Gerow Col. 3:62-4:22. Neither, does Koza teach or suggest determining a jackpot winner "randomly at the time the game ticket is dispensed." Rather, Koza generally describes broadcasting a winning number to a ticket after the player has the ticket and broadcasting the winning number lottery to the ticket. Koza Col. 2:39-40. Neither does Haste teach or suggest determining a jackpot winner "randomly at the time the game ticket is dispensed." Rather, Haste generally describes a pull-tab dispenser for pull-tab instant win games with predetermined winners. Neither Gerow, nor Koza, nor Haste, nor their combination teach or suggest "starting to accumulate a new prize pool upon the detection of the dispensing of an additional ticket after the detection of said winner." Thus, Applicant respectfully submits that claim 28 is not obvious. Applicant respectfully requests withdrawal of this rejection.

Moreover, with regard to claims 27 and 28, Applicant also respectfully traverses the proposed combination of Gerow, Koza and Haste because the Examiner has not provided a proper motivation to combine. Because there is no particular suggestion from a cited reference, or an affidavit of official notice, Applicant respectfully submits the Examiner's combination is improper and respectfully request withdrawal of the section 103 rejections.

VII. CONCLUSION

In light of the foregoing arguments, Applicant respectfully submits that all pending claims are in condition for allowance. The claimed invention is new, non-obvious, and useful. All issues raised by the Examiner have been addressed, and prompt reconsideration and allowance of the present application are earnestly solicited. Applicants respectfully request withdrawal of all rejections. The Examiner is invited to contact the below-named attorney for any outstanding issues in connection with this application.

Respectfully submitted,

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Dated: Aug. 16, 2004 By: _____

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